

Remarks/Arguments

Statement of Common Ownership

The undersigned attorney hereby states:

U.S. Patent Application No. 10/811,348 (the instant application) and U.S. Patent No. D459,744 were, at the time the invention of U.S. Patent Application No. 10/811,348 was made, commonly owned or subject to a duty of assignment to Leica Microsystems ("Leica"). Leica Microsystems Wetzlar GmbH and Leica Microsystems AG are divisions of the same company, Leica.

The Rejection of Claims 1-6, 8-12, 14-17, 19 and 20 Under 35 USC §102(b)

In the Office Action of August 2, 2005 Examiner rejected Claims 1-6, 8-12, 14-17, 19 and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. D459,744 (Apotheloz). Applicants respectfully traverse this rejection and requests reconsideration.

Applicants courteously point out that Claims 1-8 have been cancelled and thus the rejection of those claims has been rendered moot. Claim 15 has been amended to recite that the microscope arm is curved. Claim 15 also recites an inner recess surface that is arcuate. Claim 20 has been amended to also recite that the microscope arm is curved and also recite that the interior and exterior surface of the microscope arm is curved. These elements are all missing from the microscope disclosed in the '744 patent.

Claim 15:

As you know, each and every element of the invention as claimed must be found in a single prior art reference in order for a claim to be anticipated. Applicants respectfully submit that the '744 patent fails to teach every element of the claimed invention as recited in Claim 15. As seen in Figure 2 below, the microscope arm in the '744 patent is I-shaped and is not curved. Neither does the '744 patent teach a **curved (arcuate) inner recess surface** on the interior surface of the microscope arm, as can be seen in Figure 3 below. The present application clearly discloses and claims a **curved inner recess surface** by using the term arcuate. In Figure 1 below,

the original Figure 1 from the present patent application has been reproduced in reduced size with the curved microscope arm and the curved inner recess surface highlighted. This was done to emphasize the existence of a curved inner recess and microscope arm in the present application and the absence of such in the '744 patent. These images demonstrate that independent Claim 15 of the present application is not anticipated by the '744 patent since this reference is missing two critical elements of Claim 15, namely, an arcuate inner recess surface and a curved microscope arm.

Applicants respectfully disagree with the Examiner's position that Apotheloz is an enabling reference which teaches the claimed subject matter of an arcuate inner recess on the interior surface of the microscope arm. Apotheloz shows a microscope arm with an arcuate surface along the rear edge of the microscope arm, but the cavity on the inner surface is not completely shown. It is impossible to determine from the drawings in Apotheloz, with any certainty, whether the cavity on the inner surface is arcuate, square, or some other shape entirely. The Examiner has presumed that since the outer rear edge of the microscope arm has an arcuate surface, the cavity on the inner surface is arcuate as well. Drawings and pictures can be used to anticipate claims if they clearly show the structure which is claimed (See MPEP §2125; *In re Mraz*, 455 F.2d 1069). Apotheloz does not clearly show an arcuate inner recess on the interior surface of the microscope arm. As Applicants understand the law on this point, there is a prohibition on drawings being used to anticipate claims if the drawing does not clearly show the structure which is claimed. Hence, Apotheloz is not an enabling reference that teaches an arcuate inner recess on the interior surface of a microscope arm. Since the arcuate inner recess recited in Claim 15 is not taught by Apotheloz, Claim 15 is not anticipated by Apotheloz. Applicants respectfully request reconsideration and passage to allowance of Claim 15.

Claim 9:

Claim 9 was also rejected as anticipated by the '744 patent, but Applicants argue that the rejection was improper because the curved microscope arm that is claimed in the original wording of Claim 9 is not found in Apotheloz. Claim 9 covers a recessed portion that exists on an arcuate microscope arm. Figures 1 (a reduced version of Figure 1 from the present

application), 2 (a reduced version of Figure 1 from the '744 patent) and 3 (a reduced version of Figure 4 from the '744 patent) below starkly contrast the presence of a curved microscope arm in the present application, and the absence of that element in the '744 patent.

The Examiner points to Figures 1-12, in particular, Figures 1-4 in the '744 patent as substantiation that Apotheloz teaches a C-shaped microscope stand. For clarification, the portion of the microscope that supports the optical system and turret in the present application is the microscope arm. The stand is a separate element of the microscope that is at the base of the microscope. The stand is attached to base of the curved microscope arm in the present application, but it is not associated with the curved microscope arm recited in Claim 9. Applicants have not claimed a microscope with a curved stand, but have claimed a microscope with a curved microscope arm.

Assuming *arguendo* that a microscope arm is equivalent to a stand, which it is not, Apotheloz still fails to teach every element recited in Claim 9. The Examiner has indicated that a first section, which supports the microscope, and a second section, which connects the first section to the base, are what define the C-shape that anticipates the curved microscope arm. However, by combining these two separate elements from the '744 patent the Examiner has misinterpreted and misapplied the teachings of the reference. The first section is not part of the arm, but is an objective mount that forms no part of the microscope arm. One of ordinary skill in the art would not equate the objective mount (the "first section") with part of the microscope arm, especially in this case, where it is evident that the objective mount is a moving part. Microscope arms or stands are stationary elements that parts of the microscope are attached to.

The second section is indeed a microscope arm, but the drawings do not describe an arcuate microscope arm, but describe a straight microscope arm with only an arcuate edge (see Figures 2 and 3 below). Consequently, an element of Claim 9, specifically an arcuate microscope arm, is not taught by the '744 patent.

Claim 20:

Claim 20 was rejected as being anticipated by Apotheloz. Claim 20 recites "a *curved* microscope arm having an interior surface and a *curved exterior surface*; said *curved*

interior surface comprising at least one recessed portion, said at least one recessed portion extending from said curved interior surface of said curved microscope arm to an *arcuate inner recess surface* of said curved microscope arm, said recessed portion comprising a surface for gripping said microscope.” (emphasis added) The Examiner asserts that Apotheloz anticipates Claim 20, but it is impossible to determine from the invention shown in Figures 1-12 of Apotheloz if the recess on the interior surface of the arm in Apotheloz is arcuate given the drawings provide, which means that Apotheloz is not an enabling reference that teaches an arcuate inner recess. See discussion *supra*.

Applicants submit that for all of the above reasons independent Claims 9, 15 and 20 are novel, and thus respectfully requests reconsideration and withdrawal of the rejections of those claims.

Claims 10-14, 16-19 and 21-27 depend from Claims 9, 15 and 20 respectively, and thus incorporate all the limitations of those claims and are likewise novel with respect to the ‘744 patent. Applicants respectfully request reconsideration and withdrawal of the rejections to Claims 10-14, 16-19, 21-27 and passage to allowance of those claims.

The Rejection of Claims 7, 13 and 18 Under 35 USC 103(a)

The Examiner rejected Claims 7, 13 and 18 under 35 USC §103(a) as being unpatentable over U.S. Patent No. D459,744 (Apotheloz) in view of Stevens. Applicants respectfully request reconsideration and traverse the rejection.

Claim 7 has been cancelled which renders the rejection of that claim moot.

Both Apotheloz and the present application were commonly owned by Leica at the time the invention of the present application was made. Under 35 U.S.C. § 103(c), subject matter developed by another person or entity, which qualifies as prior art only under § 102(e) does not preclude patentability if that subject matter was owned by the same person at the time the invention was made.

As stated in the Statement of Common Ownership above, Apotheloz and the invention of the present application were commonly owned or subject to an obligation of assignment to Leica

at the time the invention in Claims 13 and 18 of the present application was made. Due to common ownership of Apotheloz and the claimed invention, Under 35 USC §103(c), Apotheloz cannot be cited as prior art against Claims 13 and 18. Because Apotheloz is cited against Claims 13 and 18, the current rejection of Claims 13 and 18 under § 103(a) should be withdrawn and those claims passed to allowance. Applicants respectfully request withdrawal of the rejection of Claims 13 and 18 and passage to allowance of those claims.

Assuming *arguendo* that Apotheloz was not disqualified as prior art, the combination of Apotheloz with Stevens would still fail to establish a prima facie case of obviousness for the present invention. In accordance with *In re Vaeck*, the prior art references combined must teach or suggest all the claim limitations. Applicants have shown supra that Apotheloz '744 does not teach all the limitations of Claims 9 and 15. Nor does Apotheloz suggest all the limitations of Claims 9 and 15. Therefore, Claims 9 and 15 are patentable over Apotheloz and Applicants respectfully request reconsideration and withdrawal of the rejections to Claims 9 and 15 and passage to allowance of those claims. Claims 13 and 18, dependent from Claims 9 and 15 respectively, enjoy the same distinction from Apotheloz '744 and Applicants request reconsideration and withdrawal of the rejections of Claims 13 and 18, and passage to allowance of those claims.

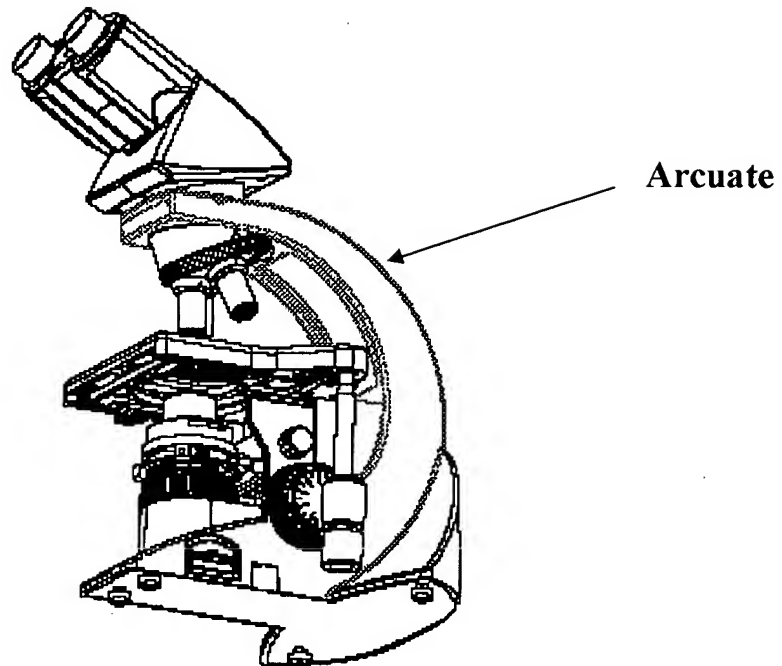


Fig. 1 - 10/811,348

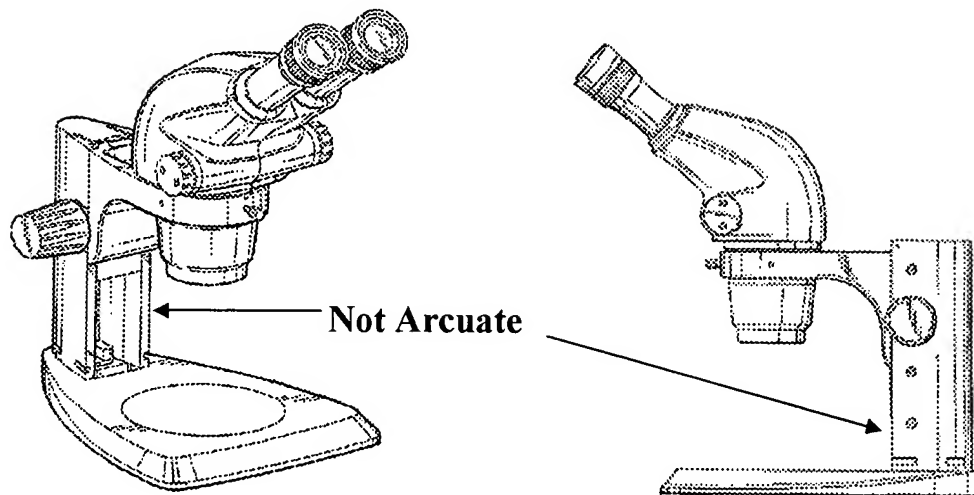


Fig. 2 - '744 Patent

Fig. 3 - '744 Patent

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Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,

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